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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,659	08/31/2001	Christopher A. Mesa	10017722-1	1784

7590 02/15/2007
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

CHUONG, TRUC T

ART UNIT	PAPER NUMBER
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2179

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/944,659	MESA ET AL.	
	Examiner	Art Unit	
	Truc T. Chuong	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the Appeal Brief, filed 10/19/06. Claims 23-31 are pending in this communication, and this office action is made non-final.

2. Reopening of Prosecution After Appeal Brief or Reply Brief

In view of the Appeal Brief filed on 10/19/06, PROSECUTION IS HEREBY REOPENED. The new ground(s) of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: a computer readable medium as claimed in claims 28 and 31 is not

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specifically defined what exactly the computer readable medium is from a list of hardware and devices listed in the specification (pages 18-19). The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrase used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 23-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Monty et al. (“Monty”, U.S. Patent No. 5,799,070).

As to claim 23, Monty shows a scanning method, comprising:

displaying a user interface (fig. 1 shows the front panel 10 of the fax machine using the programmed dialing the fax numbers, e.g., col. 3 lines 28-33) from which one or more of multiple destination devices (the receiving fax, e.g., col. 3, lines 40-45) may be selected to receive data from an input peripheral having a scanning capability (the fax machine will make the connection with the receiving fax and scanning the document when the receiving fax is ready, e.g., col. 3 lines 27-48);

the input peripheral notifying a selected destination device that the device has been selected to receive data (e.g., col. 3 lines 40-44);

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in response to the notifying, the selected destination device requesting that the input peripheral begin transmitting data to the selected destination device (e.g., col. 3 lines 30-67);

in response to the requesting, the input peripheral scanning a document and transmitting data representing the document to the selected destination device (Monty clearly teaches that the input device/fax only start scanning and transmitting the document when the destination device is ready/established to receive scanned/faxed data, e.g., col. 3 lines 35-48).

As to claim 24, Monty shows the method wherein the input peripheral comprises a scanner or a multifunction peripheral (fax machine, e.g., col. 3 lines 44-48).

As to claim 25, Monty shows the method further comprising displaying a user interface from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral and wherein the input peripheral scanning a document and transmitting data representing the document to the selected destination device comprises the input peripheral scanning the document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral (Monty shows that the user can dial the fax number (a resource) from the front panel/user interface 10, e.g., col. 3 lines 28-42, and fig. 1).

As to claim 26, Monty shows the method wherein the resource comprises an application program, a telephone number for a facsimile transmission of the data (programmed dial stored numbers in memory, e.g., col. 3 lines 30, and 49-62); Monty also teach an email address to send the data (column 3, lines 35-48).

As to claim 27, Monty shows scanning method, comprising:

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displaying a user interface from which one or more of multiple destination devices (Note the rejection of claim 23 above) may be selected to receive data from an input peripheral having a scanning capability and from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral (Monty shows that the user can dial the fax number (the resource) from the front panel/user interface 10, e.g., col. 3 lines 28-42, and fig. 1) may be selected to receive data from an input peripheral having a scanning capability (the fax machine will make the connection with the receiving fax and scanning the document when the receiving fax is ready, e.g., col. 3 lines 27-48);

the input peripheral notifying a selected destination device that the device and a resource on the device have been selected to receive data (e.g., col. 3 lines 40-44);

in response to the notifying, the selected destination device acknowledging a notification from the input peripheral (e.g., col. 3 lines 30-67); and

in response to an acknowledgement from the selected destination device, the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral (Monty clearly teaches that the input device/fax only start scanning and transmitting the document when the destination device is ready/established to receive scanned/faxed data, e.g., col. 3 lines 35-48).

As to claims 28-31, they are the equivalent claims to method claims 23-25, and 27 respectively and are rejected under a similar rationale.

Conclusion

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Truc T. Chuong whose telephone number is 571-272-4134. The examiner can normally be reached on M-Th and alternate Fridays 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Truc T. Chuong

01/19/07


WEILUN LO
SUPERVISORY PATENT EXAMINER